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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,977	01/11/2000	PAUL J. GODOWSKI	P1084R1C1	5001

9157 7590 05/04/2005

GENENTECH, INC.
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SOUTH SAN FRANCISCO, CA 94080

EXAMINER

HOLLERAN, ANNE L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/480,977

Applicant(s)

GODOWSKI ET AL.

Examiner

Anne Holleran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 39-45 is/are pending in the application.
- 4a) Of the above claim(s) 40-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed January 18, 2005 and the signed declaration filed January 27, 2005 under 37 C.F.R. 1.131 are acknowledged. Claims 1, 4 and 39 are pending and examined on the merits.

Claim Rejections Maintained:

2. Claims 1, 4, and 39 remain rejected under 35 U.S.C. 102(e) as being anticipated by Young (U.S. Patent 6,727,077; issued Apr. 27, 2004; effective filing date 6/17/1997).

Applicants' arguments and declaration filed under 37 C.F.R. 1.131 have been carefully considered but are insufficient to overcome the rejection of record. Rule 1.131 states that a prior invention may not be established under rule 1.131 if the rejection is based on a U.S. patent to another where the patent contains claims to the same patentable invention as defined in 37 C.F.R. 1.601(n). 37 C.F.R. 1.601(n) defines the "same patentable inventions" as an invention that is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103(a)) in view of a second invention. In this case, the claim 1 of Young are drawn in part to a nucleic acid encoding amino acid residues 1-157 of SEQ ID NO: 2. SEQ ID NO: 2 (which is 157 amino acids in length) comprises SEQ ID NO: 4 of the instant application. Therefore, Young claims an invention that is the same as the invention claimed in the instant application.

Applicants' attention is drawn to MPEP 2308.01, which instructs applicant to file a statement under 37 C.F.R. 1.608(a) or 37 C.F.R. 1.608(b) when a patent claims the same invention as what is claimed in an application to another. See also MPEP 2138.03: Interference practice operates to the exclusion of ex parte practice under 37 CFR 1.131 which permits an

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applicant to show an actual date of invention prior to the effective date of a patent or literature reference applied under 35 U.S.C. 102(a) or (e), as long as the patent is not a domestic patent claiming the same patentable invention. Ex parte Standish, 10 USPQ2d 1454, 1457 (Bd. Pat. App. & Inter. 1988) (An application claim to the “same patentable invention” claimed in a domestic patent requires interference rather than an affidavit under 37 CFR 1.131 to antedate the patent. The term “same patentable invention” encompasses a claim that is either anticipated by or obvious in view of the subject matter recited in the patent claim.). Subject matter which is available as prior art only under 35 U.S.C. 102(g) is by definition made before the applicant made his invention and is therefore not open to further inquiry under 37 CFR 1.131.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Office should be directed to Anne Holleran, Ph.D. whose telephone number is (571) 272-0833.

Examiner Holleran can normally be reached Monday through Friday, 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 571-1600.

Anne L. Holleran

Patent Examiner

April 29, 2005



ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER